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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,960	06/04/2001	Kazuhiro Kudoh	00-169925	2545
21254	7590	01/12/2006	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			GAUTHIER, GERALD	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/871,960

Applicant(s)

KUDOH, KAZUHIRO

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 30-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claim(s) 1-12, 31 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan (US 5,903,628) in view of Muramatsu (US 2001/0051536 A1), in view of Henderson (US 6,611,681 B2) and in further view of Heie (US 6,473,621 B1).

Regarding **claim(s) 1, 6, 9 and 10**, Brennan discloses a mobile communications terminal device (FIG. 1 and column 4, lines 17-21), comprising:

storage means (Data Memory 42 on FIG. 1) for registering beforehand a name of an originator, one of the telephone number and a mail address of the originator, a kind of an incoming identification tone at a time of a call incoming from the originator and a

character string input by the user and corresponding to a voice information designating the originator (column 4, lines 31-47);

control means (Main Controller 134 on FIG. 1) for controlling the voice output means to output the voice information corresponding to the character string registered beforehand in the storage means (column 4, lines 48-65).

Brennan discloses the user entering a plurality of telephone numbers and associated names and addressees into the memory prior receiving an incoming call (column 2, lines 45-59).

Note, recording an incoming identification tone to identify a caller is well known.

For example, Muramatsu, in the same field of endeavor, teaches a voice output means for ringing with the kind of the incoming identification tone corresponding to the originator at the time of the call incoming (§ 0033, § 0061).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Brennan using the sounds patterns memory as taught by Muramatsu.

This modification of the invention would offer the capability of recording a sound pattern such as the system would allow the user to recognize whom is calling before the phone goes off-hook.

Brennan in combination with Muramatsu discloses reading the voice announcement recorded previously to announce the caller over the speaker to the called party but fails to disclose in response to an instruction received from said user while the voice output means is ringing.

However, Henderson, in the same field of endeavor, teaches in response to an instruction received from a user while the voice output means is ringing (FIG. 1 and column 7, lines 4-9).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Brennan in combination with Muramatsu using the talk button as taught by Henderson.

This modification of the invention would offer the capability of announcing the caller so that the user would recognize whom is calling before the phone goes off-hook.

Brennan in combination with Muramatsu and Henderson discloses a character string but fails to show a character string input by a user.

However, Heie teaches a character string input by a user (column 4, lines 1-20).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Brennan in combination with Muramatsu and Henderson with the teaching of character strings inputted by user as taught by Heie.

This modification of the invention would offer the capability of a character string input by a user so that the user would replace the name on a text message.

Regarding **claim(s) 2 and 7**, Brennan discloses the control means controls the voice output means to output the voice information after stopping the ringing in response to the instruction (column 3, lines 3-31).

Regarding **claim(s) 3 and 8**, Brennan discloses the control means controls the voice output means to output the voice information after reducing an output volume of ringing in response to the instruction (column 4, lines 48-65).

Regarding **claim(s) 4**, Muramatsu teaches the voice output means outputs the voice information corresponding to one of the telephone number and the mail address of the originator as the incoming identification tone at the time of the call incoming (¶ 0033).

Regarding **claim(s) 5**, Brennan discloses the voice output means outputs the primary information regarding one of the discriminating ringing and the originator as the voice information instead of the incoming identification tone (column 3, lines 3-31).

Regarding **claim(s) 11**, Brennan discloses the instruction comprises an input from a switch mounted on an exterior of the mobile communication terminal device (column 3, lines 3-31).

Regarding **claim(s) 12**, Brennan discloses the outputting of the voice information is in response to an external instruction during the ringing (column 4, lines 48-65).

Regarding **claim(s) 31**, Muramatsu teaches the mobile communications terminal device further comprising means for receiving said character string from the user (¶ 0061).

Regarding **claim(s) 32**, Muramatsu teaches the method comprising receiving said character string from the user before said ringing (¶ 0061).

4. **Claim(s) 13-18, 21, 22 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson in view of Heie.

Regarding **claim(s) 13**, Henderson discloses a communications terminal (column 4, lines 17-21) comprising:

a memory storing a character string, the character string to be retrieved from the memory upon a receipt of a call from the calling party for outputting voice information (FIG. 1 and column 5, lines 52-59) and upon receipt of an instruction from a user during an incoming call (FIG. 1 and column 7, lines 4-9).

Henderson discloses a character string but fails to show a character string input by a user.

However, Heie teaches a character string input by a user (column 4, lines 1-20).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Henderson with the teaching of character strings inputted by user as taught by Heie.

This modification of the invention would offer the capability of a character string input by a user so that the user would replace the name on a text message.

Regarding **claim(s) 14**, Henderson discloses a speaker (30 on FIG. 1); and a controller that controls the speaker to output the voice information in response to a call from the calling party based upon the character string that was stored before the call from the party and upon receipt of the instruction (column 7, lines 4-9).

Regarding **claim(s) 15**, Henderson discloses a converter that converts the character string into an analog voice waveform (column 5, lines 52-59).

Regarding **claim(s) 16**, Henderson discloses a switch to receive the instruction and to control a retrieval of the character string and a conversion of the character string into an analog waveform (column 7, lines 4-9).

Regarding **claim(s) 17**, Henderson discloses a speaker in communication with the memory (column 5, lines 52-59).



Regarding **claim(s) 18**, Henderson discloses the controller determines whether the call is from the party based upon caller identification data (column 6, lines 31-39).

Regarding **claim(s) 21**, Henderson discloses the character string comprises a digitized voice signal (column 5, lines 52-59).

Regarding **claim(s) 22**, Henderson discloses the memory comprises a telephone directory that stores the character string (column 5, lines 52-59).

Regarding **claim(s) 23**, Henderson discloses the communications terminal comprises a mobile communications terminal (column 5, lines 60-63).

5. **Claim(s) 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henderson in view of Heie as applied to **claim(s) 13 and 14** above, and further in view of Muramatsu.

Regarding **claim(s) 19**, Henderson in combination with Heie as applied to **claim(s) 13** differ from **claim(s) 19** in that it fails to disclose the memory further stores a tone for the party.

However, Muramatsu, in the same field of endeavor, teaches the memory further stores a tone for the party (¶ 0033).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Henderson in combination with Heie using the memory as taught by Muramatsu.

This modification of the invention would offer the capability of announcing the caller with a tone so that the user would recognize whom is calling before the phone goes off-hook.

Regarding **claim(s) 20**, Muramatsu teaches the controller controls the speaker to output the tone in response to a call from the party (§ 0061).

6. **Claim(s) 24-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan in view of Henderson and in further view of Heie.

Regarding **claim(s) 24**, Brennan discloses a method for identifying a caller in a mobile terminal (FIG. 1 and column 4, lines 17-21) comprising:

determining whether a memory includes a character string input by a user that corresponds to a caller (FIG. 1 and column 4, lines 48-51); and

outputting a voice signal that corresponds to said character string corresponds to said caller (FIG. 1 and column 4, lines 51-65).

Brennan discloses reading the voice announcement recorded previously to announce the caller over the speaker to the called party but fails to disclose in response to an instruction received from said user while the voice output means is ringing.

However, Henderson, in the same field of endeavor, teaches in response to an instruction from said user during an incoming call from the caller (FIG. 1 and column 7, lines 4-9).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Brennan using the talk button as taught by Henderson.

This modification of the invention would offer the capability of announcing the caller so that the user would recognize whom is calling before the phone goes off-hook.

Brennan in combination with Henderson discloses a character string but fails to show a character string input by a user.

However, Heie teaches a character string input by a user (column 4, lines 1-20).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Brennan in combination with Henderson with the teaching of character strings inputted by user as taught by Heie.

This modification of the invention would offer the capability of a character string input by a user so that the user would replace the name on a text message.

Regarding **claim(s) 25**, Brennan discloses receiving caller identification data and wherein the determining comprises determining whether the character string

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corresponds to the caller based upon the caller identification data (column 3, lines 3-31).

Regarding **claim(s) 26**, Brennan discloses storing the character string in a telephone directory before the determining (column 2, lines 45-59).

7. **Claim(s) 27, 28 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Brennan in view of Henderson and in view of Heie as applied to **claim(s) 24 and 26** above, and further in view of Muramatsu.

Regarding **claim(s) 27**, Brennan in combination with Henderson and Heie as applied to **claim(s) 26** differ from **claim(s) 27** in that it fails to disclose outputting the tone if the tone corresponds to the caller before outputting the voice signal.

However, Muramatsu teaches storing a tone in the telephone directory (§ 0033); determining whether the tone corresponds to the caller (§ 0033); and outputting the tone if the tone corresponds to the caller before outputting the voice signal (§ 0061).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Brennan in combination with Henderson and Heie using the memory as taught by Muramatsu.

This modification of the invention would offer the capability of outputting the tone if the tone corresponds to the caller before outputting the voice signal so that the user would recognize whom is calling before the phone goes off-hook.

Regarding **claim(s) 28**, Muramatsu teaches initially running an identification tone in response to a call from the caller (¶ 0061).

Regarding **claim(s) 30**, Muramatsu teaches the instruction comprises a prompt by a user for the output of the voice signal while an identification tone, corresponding to the caller, is ringing (¶ 0061).

### ***Response to Arguments***

8. Applicant's arguments with respect to **claim(s) 1-28 and 30-32** have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GERALD GAUTHIER**  
**PATENT EXAMINER**

Gerald Gauthier  
Examiner  
Art Unit 2645

g.g.  
January 9, 2006